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NIKON CORPORATION  
and NIKON INC.

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA  
WESTERN DIVISION

CARL ZEISS AG and ASML  
NETHERLANDS, B.V.,

Plaintiffs,

v.

NIKON CORPORATION, SENDAI  
NIKON CORPORATION, and  
NIKON INC.,

Defendants.

Case No. 2:17-cv-03221 RGK (MRWx)

**DEFENDANTS NIKON  
CORPORATION AND NIKON  
INC.'S OBJECTIONS TO  
DEMONSTRATIVE EXHIBITS  
FOR DR. JOHN J. P. KELLY**

Trial Date: July 11, 2018  
Time: 9:00 a.m.  
Courtroom: 850, 8th Floor

Hon. R. Gary Klausner

1 Plaintiffs have disclosed several prejudicial and irrelevant demonstrative  
 2 slides to use with their expert Dr. John Kelly. Many of the subjects and/or opinions  
 3 disclosed on the slides were **never** disclosed in Dr. Kelly's expert report.  
 4 Accordingly, Plaintiffs should not be allowed to present the jury with demonstrative  
 5 exhibits containing references to prejudicial and irrelevant evidence, or references  
 6 to expert opinions that were never disclosed in any report or at any expert  
 7 deposition. These slides should therefore be excluded.

8 **A. PDX 628 – 638<sup>1</sup> Should Be Excluded Because Plaintiffs Failed to**  
 9 **Present Evidence on Marking in Their Case-in-Chief and Dr.**  
 10 **Kelly Did Not Substantively Opine on Marking in His Expert**  
 11 **Report**

11 Plaintiffs bear the affirmative burden of proving compliance with the  
 12 marking statute, including the burden of proving—at trial—that the unmarked  
 13 products identified by Nikon during discovery do not practice the asserted patents.  
 14 *Arctic Cat Inc. v. Bombardier Rec. Prods.*, 876 F.3d 1350, 1367 (Fed. Cir. 2017)  
 15 (“the burden of proving compliance with marking is and ***at all times*** remains on the  
 16 patentee”) (emphasis added).<sup>2</sup> Plaintiffs failed to carry that burden because they  
 17 failed to put on any evidence for marking issues during their case-in-chief. All of  
 18 their demonstrative exhibits regarding marking (PDX 628-630) should therefore be  
 19 excluded as improper and irrelevant.

20 Several of Plaintiffs' marking slides are also improper for a number of  
 21 additional reasons. PDX 629 and 636 refer to the HP products that practice the

22 <sup>1</sup> All slides referenced in these objections are attached as Exhibit A.

23 <sup>2</sup> As found by the Court, Nikon has already met the “low bar” of its burden of  
 24 production. (ECF No. 249 at 17-18.) (In its Order for Partial Summary Judgment,  
 25 explaining “Defendants additionally identified that HP is licensed to sell products  
 26 practicing the '792 and '167 Patents via a licensing agreement which Defendants  
 27 allege does not require HP to mark the patented products. **This is sufficient to meet**  
 28 **Defendants' burden of production** because Defendants articulated “specific  
 unmarked products” which they believe practice the patents. *Arctic Cat*, 876 F.3d at  
 1368 (explaining that the alleged infringer's burden of production is a “low bar.”).

1 '792 and '167 Patents as “discontinued HP cameras [and tablet].” But whether HP  
2 discontinued production and sale of its cameras and tablets is irrelevant to the  
3 marking analysis. There is no exception in 35 U.S.C. § 287 for products that are no  
4 longer being sold. These irrelevant statements will only serve to improperly  
5 mislead the jury regarding marking requirements. PDX 629 and 636 should be  
6 excluded under FRE 402 and 403.

7 PDX 630-632 are improper because they attempt to shift Plaintiffs’ burden  
8 on marking to Nikon. PDX 630 argues that “Nikon provided analysis only for  
9 claims 1 and 28.” PDX 631 and 632 assert that there is “no evidence” that certain  
10 limitations are present in the HP products. But Nikon need not provide analysis on  
11 *any* claims, nor is Nikon required to present any evidence that the HP products  
12 practice the asserted patents’ claims. “The burden of proving compliance with  
13 marking is and at all times remains on the patentee.” *Arctic Cat*, 876 F.3d at 1367.  
14 Thus, *Plaintiffs*, not Nikon, must adduce sufficient evidence at trial to affirmatively  
15 prove that the HP products *do not* practice any of the '792 and '167 Patents’ claims.  
16 The assertions in PDX 630-632 imply otherwise, and are therefore improper,  
17 prejudicial, and contrary to well-established law. The slides should be excluded  
18 under FRE 402 and 403.

19 PDX 630, 633, 634, 638 each contains expert opinions regarding marking  
20 that were never properly disclosed during discovery. PDX 630, 633, and 634  
21 include references to claims 23 and 27 of the '792 Patent. But Dr. Kelly failed to  
22 disclose any opinions with respect to those claims in his report or at his deposition.  
23 PDX 634 asserts that “‘There are no printing images’ is not user error.” Dr. Kelly  
24 never disclosed this opinion in his report or at his deposition. PDX 638 argues that  
25 the “digital camera” and “sensing activation of viewfinder display” limitations are  
26 not found in the HP tablet. But again, Dr. Kelly never properly disclosed these  
27 theories in his report or at his deposition. These slides should therefore be excluded  
28 under Rules 26 and 37(c)(1); *See Yeti by Molly, Ltd. v. Deckers Outdoor Corp.*, 259

1 F.3d 1101, 1106 (9th Cir. 2001).

2 **B. PDX 602 Improperly Instructs the Jury on the Burden of Proof**

3 Plaintiffs' PDX 602 improperly usurps the Court's role of instructing the jury  
4 on the applicable law and burden of proof. PDX 602 references a statute and  
5 includes a depiction of the "clear and convincing evidence" burden of proof on  
6 scales of justice. This reference and depiction improperly instruct the jury on the  
7 applicable law and are prejudicial to Nikon.

8 **C. PDX 605 and PDX 608 Improperly Include Expert Opinions Never  
9 Disclosed Previously**

10 PDX 605 and PDX 608 improperly reference expert opinions that Dr. Kelly  
11 never disclosed in his report or at his deposition. For example, PDX 608 asserts  
12 that "Toyofuku does not describe how the warning regarding zero frames is  
13 provided." An expert's report must provide "a complete statement of all opinions  
14 the witness will express and the basis and reasons for them." Fed. R. Civ. P.  
15 26(a)(2)(B)(1). Nikon will be highly prejudiced if Plaintiffs are allowed to present  
16 at trial these never-disclosed expert opinions. The slides should therefore be  
17 excluded. Fed. R. Civ. P. 37(c)(1); *Yeti by Molly*, 259 F.3d at 1106.

18 **D. PDX 625 and 627 Make Irrelevant and Misleading Assertions  
19 About Non-Infringing Alternatives**

20 PDX 625 and 627 should be excluded because they make irrelevant  
21 assertions about the requirements for non-infringing alternatives. In PDX 625,  
22 Plaintiffs assert that Nikon's proposed design-around is not a true design-around  
23 because "flashing and static arrows would still convey an error message." But  
24 "flashing and static arrows" is not accused of infringement in this case, and Dr.  
25 Kelly never disclosed any such opinions in his report. The statement is therefore  
26 irrelevant and misleading. In PDX 627, Plaintiffs assert that the non-infringing  
27 alternative "[w]ould remove the benefit of the invention." This is also irrelevant  
28 and misleading because "benefit of invention" is not a legal requirement for a non-

1 infringing alternative. Accordingly, PDX 625 and 627 should be excluded under  
2 FRE 402 and 403.

3 **CONCLUSION**

4 For the foregoing reasons, Nikon requests that the above-mentioned  
5 demonstrative slides be excluded.

6  
7 Dated: July 17, 2018

Respectfully submitted,

8 JACK LONDEN  
9 VINCENT J. BELUSKO  
10 MORRISON & FOERSTER LLP

11 By: /s/ Vincent J. Belusko  
12 Vincent J. Belusko

13 Attorneys for Defendants  
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16 AND NIKON INC.  
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